

### **REMARKS**

In the present amendment, claims 39, 41, 42, and 43 have been amended. Claim 40 has been cancelled without prejudice or disclaimer. Support for the amendments can be found in the claims as originally filed and throughout the specification. No new matter has been added by the claim amendments.

The claim listing above reflects amendments to the claims as pending prior to the Amendment After Final dated June 8, 2006; the Advisory Action indicated that the amendments presented in that Amendment After Final were not entered.

It is believed that the above amendments may be properly entered at this time, i.e. after final rejection, pursuant to 37 CFR §1.116, because the amendments cancel claims and reduce issues for appeal. Indeed, it is respectfully submitted that the amendments place the application in condition for allowance. Thus, entry of the amendments at this time is earnestly solicited.

Applicant notes with appreciation the indication of allowable subject matter, i.e., that claim 38 stands allowed.

#### **Rejection of claims under 35 U.S.C. §112, second paragraph**

Claim 40 was previously rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40 has been cancelled by the within amendment without prejudice or disclaimer thereby obviating the rejection. The pending claims are believed to be fully compliant with the requirements of 35 U.S.C. §112, second paragraph. Reconsideration and withdrawal of the rejection are therefore requested.

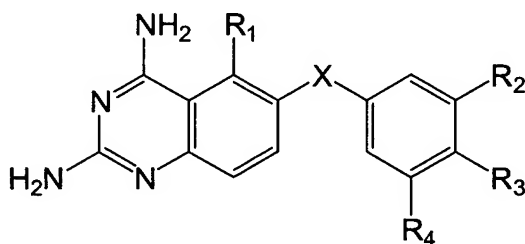
#### **Rejection of claims under 35 U.S.C. §102(b)**

Claims 39-49 and 55 were rejected (in the Final Office Action) under 35 U.S.C. §102(b) as being allegedly unpatentable over Broughton et al. (Antimicrobial Agents and Chemotherapy, 1348-1355, 1991). However, as the Examiner appears to acknowledge in the Advisory Action, the compounds of Broughton et al. differ from the compounds as presently claimed (and as previously pending). Thus, the Broughton et al. reference does not, and cannot, anticipate the pending claims. Reconsideration and withdrawal of this rejection is proper and the same is requested.

Rejection of claims under 35 U.S.C. §103(a)

Claims 39-49 and 55 were rejected (in the Final Office Action) under 35 U.S.C. §103(a) as being allegedly unpatentable over Broughton et al. (Antimicrobial Agents and Chemotherapy, 1348-1355, 1991).

As Applicant has previously indicated, the Broughton document teaches, in Table 8, a series of compounds of the structure:



Broughton recites six (6) compounds of the above-referenced structure. Five of the compounds have a methyleneamino X group, i.e., a -CH<sub>2</sub>NH- residue linking the two aromatic groups. Only a single compound, 351521, has a methylene linker at the X position, and this compound discloses a dimethoxy phenyl group as the benzylic ring moiety. Each of the compounds in Table 8 has an alkyl residue at the R<sub>1</sub> position.

The Examiner asserts that one of ordinary skill in the art would be motivated by the teaching of Broughton to make compounds of Table 8 in which the R<sub>1</sub> alkyl residue is replaced by a hydrogen because exchange of methyl and hydrogen residues is an obvious variation.

Applicant respectfully disagrees, for at least the reasons discussed in the Amendment After Final dated June 8, 2006 (which are incorporated herein by reference). The teachings of Broughton would not motivate one of ordinary skill in the art to modify the compounds there disclosed so as to arrive at the compounds of the previously pending claims.

Nonetheless, to expedite allowance of the application, claims 39 and 41-43 of the application have been amended to further define the features of the invention. For instance, claim 39 has been amended to further define the substituents on the benzylic ring. It will be appreciated that the substituents  $R_A$  of claim 39, as amended, do not include methoxy groups (as disclosed by Broughton et al.). Furthermore, claim 41, as amended, is directed to compounds in which the benzylic aromatic group is unsubstituted, is substituted with chloro or fluoro group(s), or is a naphthyl group. None of these compounds are taught or suggested by Broughton et al. Claim 42, as amended, is more specifically directed to compounds in which the benzylic aromatic group is a naphthyl group, which is not taught or suggested by Broughton et al.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143.

In the present case, there is no suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the cited reference to make the presently-claimed invention, nor is there a reasonable expectation of success. A *prima facie* case of obviousness therefore cannot be

established, and the rejection must be withdrawn. Appropriate reconsideration is requested.

**CONCLUSION**

For at least the above reasons, Applicant believes this application to be in condition for immediate allowance.


The undersigned requests any extensions of time necessary for consideration of this response. Although it is not believed that any additional fees are needed to consider this submission, the Director is hereby authorized to charge our Deposit Account No. 04-1105 should any fee be deemed necessary.

If the Examiner considers that obstacles to allowance still exist, the undersigned invite a telephone call at the number indicated below.

Dated: September 11, 2006

Respectfully submitted,

By



Mark D. Russett

Registration No.: 41,281

Christine C. O'Day

Registration No.: 38,256

EDWARDS ANGELL PALMER & DODGE LLP

P.O. Box 55874

Boston, Massachusetts 02205

(617) 439-4444

Attorneys/Agents For Applicant